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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,450	12/31/2003	Sheng Dai	25016/141	9813

7590 04/05/2007
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EXAMINER

O SULLIVAN, PETER G

ART UNIT	PAPER NUMBER
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1621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/749,450	Applicant(s) DAI ET AL.	
	Examiner Peter G. O'Sullivan	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-11 and 13-20 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-11 and 13-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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Claims 1-6, 8-11 and 13-20 are pending in this application.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6, 8-11 and 13-20 are again rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for amines substituted by alkyl groups only or crown ethers and anions comprising sulfur or phosphorus, does not reasonably provide enablement for all of applicants' claimed compounds. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. Non-heterocyclic and heterocyclic amines are the subject of a number of classes in the U.S. classification. Because of the wide disparity in the structures of both the neutral ligand and anion structures in applicants' complexes, it would be hard for one skilled in the art to predict whether the resulting compounds would be neat liquids and at what temperatures since applicants' generic claims do not limit temperatures high or low at which their ionic complexes are neat liquids. Applicants' state that one could just test a complex to determine if it is liquid. Given that only a few of applicants' claimed complexes are actually made and tested and given the breadth of the claims, it would require undue experimentation to determine which complexes are liquid. Many complexes are covered by the claims that are substantially disparate structurally from the few tested and these would have to be actually made to discover their physical properties.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 9, 13 and 15-20 are again rejected under 35 U.S.C. 102(b) as being anticipated by Stockinger et al., US 4,218,377, who disclose carboxylic acid metal salt/amine complexes anticipating applicants. (s. examples where the pure complexes are for example, viscous neat liquids. Applicants' claims now include the limitation that a new liquid is formed, but in examples of Stockinger et al. wherein a viscous neat liquid is produced, it is the product formed. Applicants' claims do not exclude workup steps.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 1-5, 9, 13 and 15-20 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Stockinger et al., US 4,218,377. Stockinger et al. disclose complexes of formula I at line 53 of Col. 1. to be useful as epoxy curing agents. In columns 1 -3 are described anions comprising phosphorus and sulfur, zinc, cobalt, copper, nickel or cadmium metal ions, and amines comprising alkyl amines. In the examples are anticipating complexes which are viscous neat complexes. The instant invention differs from the teaching of Stockinger et al. in that Stockinger et al. do not specifically exemplify all of their generically disclosed complexes which overlap applicants'. It would have been prima facie obvious at the time the invention was made to one of ordinary skill in the art, to start with the teaching of Stockinger et al, to make further of their generically disclosed complexes especially in view of complexes already made and to make further compounds useful as epoxy curing agents. Applicants' claims now include the limitation that a new liquid is formed, but in examples of Stockinger et al. wherein a viscous neat liquid is produced, it is the product formed. Applicants' claims do not exclude workup steps.

No claim is allowed.


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Peter G. O'Sullivan at telephone number (571)272-0642.


PETER O'SULLIVAN
PRIMARY EXAMINER
GROUP 1200